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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,862	01/09/2002	Nobuhiro Kawamura	FUJY 19.313	8426
26304	7590	11/04/2005		
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER JEAN GILLES, JUDE	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,862

Applicant(s)

KAWASAKI ET AL.

Examiner

Jude J. Jean-Gilles

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement^(e) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/10/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

This Action is in regards to the Reply received on 08/10/2005.

Response to Amendment

1. This action is responsive to the application filed on 08/10/2005. Claims 1, 9, 18, and 25 were amended. There are no newly added claims. Claims 1-25 are pending. Claims 1-25 represent a method and apparatus for an "IP network system having providing service control function".

Response to Arguments

2. Applicant's arguments with respect to claims 1, 9, 18, and 25 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (i.e., a method with a control module determining the substitutionally providable service for every the user on the basis of the obtained performance information and the contract data, and having the corresponding service provided to a client terminal used by the user) to the claims which significantly affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pandya et al (Pandya), Patent No. 6,671,724 B1, in view of Cook (Cook), U.S. Patent No: 6,836,805 B1.

Regarding **claim 1**, Pandya teaches the invention substantially as claimed.

Pandya fully discloses a providing service control device (*fig. 9, item 132*) comprising:

a module obtaining performance information indicating a state of a traffic congestion from a monitor target network (*column 10, lines 27-34; column 12, lines 5-28*);

a module storing information, as contract data of a contract with a user, showing a service substitutionally providable corresponding to the state of the traffic congestion (*column 13, lines 4-19; fig. 9, item 138; column 11, lines 16-65*); however Pandya does not teach the details of a control module determining the substitutionally providable service for every the user on the basis of the obtained performance information and the

contract data, and having the corresponding service provided to a client terminal used by the user .

In the same field of endeavor, Cook discloses "... If the user is authenticated and authorized, the database system 522 logs contract and settlements information returned by the local database system 590 or indicated by the database system 522 in relation to local database system 590 in step 2218 before proceeding to step 2208. If the user is not known, the database system 522 proceeds to step 2212. In one embodiment, the local database system 570 uses the user authorization system 575 to check if the user is known in the local database system 570. In one embodiment, the local database system 590 uses the user authentication system 593 for authentication and authorization. [see Cook; column 22, lines 51-62]... The database system 522 then generates and transmits usage and performance statistics for the service application in the network device 562 in step 4616. Once the service is completed, the service application in the network device 562 returns the control to the user in step 4618 to select another service application in step 4602. In one embodiment, the database system 522 uses the cross connection system 583 to perform the operations disclosed in FIG. 46. In another embodiment, a third party such as the government performs the switching for surveillance or monitoring purposes. [see Cook; column 41, lines 15-34].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Cook's teachings of using a control module determining the substitutionally providable service for every the user, with the teachings of Pandya, for the purpose of " ...providing access to the access system in response to the determination that the user is allowed to use the access

system... " as stated by Cook in lines 16-20 in column 4. By this rationale **claim 1** is rejected.

Regarding **claim 2**, the combination Pandya-Cook discloses a providing service control device according to claim 1, wherein said monitor target network is an IP network including the Internet and a provider network, and said providing service control device is disposed in said provider network (see *Pandya*; column 4, lines 47-51; column 8, lines 65-67; column 10, lines 1-30).

Regarding **claim 3**, the combination Pandya-Cook discloses a providing service control device according to claim 1, wherein said control module controls at least one of a network device and a server within a provider network, and has the corresponding service provided to said client terminal used by the user (see *Pandya* column 6, lines 7-35).

Regarding **claim 4**, the combination Pandya-Cook discloses a providing service control device according to claim 3, wherein said control module changes at least one of a data size and a data quality of data transmitted by said server to said client terminal as the substitutionally providable service (see *Pandya*; column 18, lines 37-58).

Regarding **claim 5**, the combination Pandya-Cook discloses a providing service control device according to claim 4, wherein the changed data to be transmitted by said server to said client terminal are content data registered previously in said server by a content provider (see *Pandya*; column 10, lines 66-67; column 11, lines 1-15).

Regarding **claim 6**, the combination Pandya-Cook discloses a providing service control device according to claim 3, wherein said control module has a transmission

band of an Internet access line changed that is utilized by said client terminal (see *Pandya*; column 4, lines 47-61; column; column 11, lines 3-64).

Regarding **claim 7**, the combination Pandya-Cook discloses a providing service control device according to claim 1, further comprising a module notifying said client terminal of the obtained performance information (see *Pandya*; column 12, lines 44-63).

Regarding **claim 8**, the combination Pandya-Cook discloses a providing service control device according to claim 7, further comprising a module receiving a contract data change request that responds to the performance information of which said client terminal has been notified (see *Pandya*; column 11, lines 3-64).

Regarding **claim 9**, the combination Pandya-Cook discloses a network system comprising:

(A) a providing service control device comprising:

(a) a module obtaining performance information indicating a state of a traffic congestion from a monitor target network (see *Pandya*; column 10, lines 27-34; column 12, lines 5-28);

(b) a module storing information, as contract data of a contract with a user, showing a service substitutionally providable corresponding to the state of the traffic congestion (see *Pandya*; column 13, lines 4-19; fig. 9, item 138); and

(c) a control module determining the substitutionally providable service for every the user on the basis of the obtained performance information and the contract data, and having the corresponding service provided to a client terminal

used by the user [see Cook; column 22, lines 51-62; column 41, lines 15-34] ;
and (B)said client terminal comprising:

(d) a module independently obtaining performance information indicating a state of a traffic congestion from said monitor target network (see *Pandya*; column 10, lines 27-34; column 12, lines 5-28); and

(e) a module executing the contract data change request on the basis of the independently obtained performance information (see *Pandya*; column 10, lines 66-67; column 11, lines 1-15).

Regarding **claim 10**, the combination Pandya-Cook a discloses a network system according to claim 9, wherein said providing service control device further comprises a module notifying said client terminal of the obtained performance information (see *Pandya*; column 12, lines 44-63). , and

said client terminal further comprises a module receiving the performance information of which said providing service control device has notified (see *Pandya*; column 11, lines 3-64).

Regarding **claim 11**, the combination Pandya-Cook discloses a network system according to claim 10, wherein said providing service control device further comprises a module receiving the contract data change request that responds to the performance information of which said client terminal has been notified (see *Pandya*; column 11, lines 3-64), and

said client terminal further comprises a module executing the contract data change request based on the performance information of which said providing service control device has notified (*see Pandya; column 10, lines 66-67; column 11, lines 1-15*).

Regarding **claim 12**, the combination Pandya-Cook discloses a network system according to claim 11, wherein said client terminal further comprises a module controlling said client terminal itself on the basis of any one of the independently obtained performance information and the performance information of which said providing service control device has notified (*see Pandya; column 10, lines 66-67; column 11, lines 1-15*).

Regarding **claim 13**, the combination Pandya-Cook discloses a network system according to claim 9, wherein said monitor target network is an IP network including the Internet and a provider network, and said providing service control device is disposed in said provider network (*see Pandya; column 4, lines 47-51; column 8, lines 65-67; column 10, lines 1-30*).

Regarding **claim 14**, the combination Pandya-Cook discloses a network system according to claim 9, wherein said control module controls at least one of a network device and a server within a provider network, and has the corresponding service provided to said client terminal used by the user (*see Pandya; column 6, lines 7-35*).

Regarding **claim 15**, the combination Pandya-Cook discloses a network system according to claim 14, wherein said control module changes at least one of a data size and a data quality of data transmitted by said server to said client terminal as the substitutionally providable service (*see Pandya; column 18, lines 37-58*).

Regarding **claim 16**, the combination Pandya-Cook discloses a network system according to claim 15, wherein the changed data to be transmitted by said server to said client terminal are content data registered previously in said server by a content provider (see *Pandya*; column 10, lines 66-67; column 11, lines 1-15).

Regarding **claim 25**, the combination Pandya-Cook discloses a readable-by-computer recording medium recorded with a program read by a computer to execute:

obtaining performance information indicating a state of a traffic congestion from a monitor target network (see *Pandya*; column 10, lines 27-34; column 12, lines 5-28);

storing information, as contract data of a contract with a user, showing a service substitutionally providable corresponding to the state of the traffic congestion (see *Pandya*; column 13, lines 4-19; fig. 9, item 138); and

determining the substitutionally providable service for every the user on the basis of the obtained performance information and the contract data, and having the corresponding service provided to a client terminal used by the user [see *Cook*; column 22, lines 51-62; column 41, lines 15-34].

6. **Claim 18** lists all the same elements of **claim 1**, but in method form rather than device form. Therefore, the supporting rationale of the rejection to **claim 1** applies equally as well to **claim 18**.

Claim 19 lists all the same elements of **claim 3**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claim 3**

applies equally as well to **claim 19**.

Claim 20 lists all the same elements of **claim 4**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claim 4** applies equally as well to **claim 20**.

Claim 21 lists all the same elements of **claim 5**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claim 5** applies equally as well to **claim 21**.

Claim 23 lists all the same elements of **claim 7**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claim 7** applies equally as well to **claim 23**.

Claim 24 lists all the same elements of **claim 8**, but in apparatus form rather than method form. Therefore, the supporting rationale of the rejection to **claim 8** applies equally as well to **claim 24**.

Claim 17 lists all the same elements of **claim 6**, but in system form rather than device form. Therefore, the supporting rationale of the rejection to **claim 6** applies equally as well to **claim 17**.

Claim 22 lists all the same elements of **claim 6**, but in method form rather than device form. Therefore, the supporting rationale of the rejection to **claim 6** applies equally as well to **claim 22**.

Response to Arguments

7. Applicant's Request for Reconsideration filed on 08/10/2005 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

The Pandya patent fails to disclose or suggest a control module determining the substitutionally providable service for every the user on the basis of the obtained performance information and the contract data, and having the corresponding service provided to a client terminal used by the user with respect to independent claims 1, 9, 18, and 25.

8. It is the position of the Examiner that Pandya in detail teaches the limitations of the above mentioned claims. However, in view of Applicant's remarks, stating that Pandya does not teach teaches "a control module determining the substitutionally providable service for every the user on the basis of the obtained performance information and the contract data, and having the corresponding service provided to a client terminal used by the user" the Examiner uses a new reference of Cook to fully address this new clarification of the subject matter recited [see Cook; column 22, lines 51-62; column 41, lines 15-34].

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG


October 30, 2005


DAVID WILEY
SUPERVISORY PATENT EXAMINER
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